REMARKS

Claims 1-21 remain pending and under current examination. Applicant respectfully requests reconsideration of this application in view of the foregoing amendments and following remarks.

In the Office Action,[1] the Examiner objected to the drawings as failing to comply with 37 C.F.R. § 1.84(p)(5); rejected claims 1-13 under 35 U.S.C. § 101 as directed to non-statutory subject matter; rejected claims 1-4 and 6-21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,758,087 to Aaker et. al. ("Aaker"); and rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Aaker in view of U.S. Patent No. 5,765,154 to Horikiri et. al. ("Horikiri").

I. Drawings

Although Applicant respectfully traverses the objection to the drawings, Applicant has amended the specification to include reference characters 425, 410, 415, 420, 500, 505, 510, 600, 605, 610, and 615. No new matter has been added by this amendment, since the specification now merely repeats information from the originally-filed drawings. Accordingly, Applicant respectfully requests that the Examiner withdraw the objections to the drawings.

II. Claim Rejections - 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 1-13 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Although Applicants disagree

---

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

with the Examiner's rejection of claims 1-13 under 35 U.S.C. § 101, in an effort to

expedite prosecution, Applicants hereby amend claim 1 to remove the reference to an

"information carrier" and to now recite, for example, "[a] computer program product,

tangibly embodied in a computer-readable storage medium, comprising instructions

operable on a client computer." Applicants respectfully submit that independent claim 1,

as amended, and claims 2-13 which depend from independent claim 1, are directed to

statutory subject matter. Applicants therefore respectfully request the Examiner to

reconsider and withdraw the rejection of claims 1-13 under 35 U.S.C. § 101.

III. Claim Rejections - 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 1-4 and 6-21 under 35

U.S.C. § 102(b) as being anticipated by Aaker. In order to properly establish that Aaker

anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every

element of each of the claims in issue must be found, either expressly described or

under principles of inherency, in that single reference. Furthermore, "[t]he identical

invention must be shown in as complete detail as is contained in the ... claim." *See*

M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9

U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Aaker does not disclose each and every element of Applicant's claimed

invention. Amended claim 1 defines a combination of features including, for example,

"[a] computer program product, tangibly embodied in a computer-readable storage

medium, comprising instructions operable on a client computer to ... pre-process one or

more of the possible user interaction events to generate one or more possible user

interface states." The Examiner alleges that Aaker's "predicted response is generated by the server system 200 using the predict logic module 230" col. 3, lines 22-26." This is not correct.

Aaker's "response" does not include "one or more possible user interface states," as recited in claim 1. When Aaker describes an exemplary response, he shows "sequential steps for preparing a predicted response, such as, for imbedded hypertext files begin with preparing a file transfer prediction for a current document as indicated at a block 630" (col. 6, lines 54-57). Aaker predicts a file for transfer. *Id.* Also, Aaker's transferred file to client system 100 is not a predicted user interface state. As discussed throughout column 6 of Aaker, predicting and preparing a response at block (606) entails following one of the paths shown in Figures 6C and 6D (col 6, lines 2-5). Studying Figure 6C, it shows that preparing a "predicted response" includes "checking for more blocks to transfer" (col. 6, lines 42-44), but does not teach generating "interface states," as recited in claim 1. Studying Figure 6D, drawn to a web server application, it shows that preparing a "predicted response" includes "preparing a file transfer prediction" (col. 6, lines 51-57), but also does not teach generating "interface states," as recited in claim 1.

Because Aaker does not teach or suggest each and every element recited by amended claim 1, Aaker cannot anticipate this claim.

Independent claims 14 and 18, though of different scope from claim 1, recite elements similar to those set forth above for claim 1. Claims 14 and 18 are therefore

allowable for at least the reasons presented above. Claims 2-4, 6-13, 15-17 and 19-21

are also allowable at least due to their respective dependence from claims 1, 14 and 18.

IV. Claim Rejections - 35 U.S.C. § 103

Applicants respectfully traverse this rejection under 35 U.S.C. § 103. No *prima*

facie case of obviousness has been established.

> To establish a *prima facie* case of obviousness, three basic criteria must
> be met. First, there must be some suggestion or motivation, either in the
> references themselves or in the knowledge generally available to one of
> ordinary skill in the art, to modify the reference or to combine reference
> teachings. Second, there must be a reasonable expectation of success.
> Finally, the prior art reference (or references when combined) must teach
> or suggest all the claim limitations. The teaching or suggestion to make
> the claimed combination and the reasonable expectation of success must
> both be found in the prior art, and not based on applicant's disclosure. *In*
> *re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P.
> § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among

other things, neither Aaker nor Horikiri, taken alone or in combination, teaches or

suggests each and every element of Applicants' claims.

Dependent claim 5 includes all of the elements of independent claim 1, including,

for example "[a] computer program product, tangibly embodied in a computer-readable

storage medium, comprising instructions operable on a client computer to ...

pre-process one or more of the possible user interaction events to generate one or

more possible user interface states." As set forth above, Aaker fails to teach or suggest

generating "interface states," as required by claim 1.

The Examiner cites Horikiri as teaching "that hypertext files are HTML files"

(Office action, page 10). Even assuming this allegation is true, which Applicants do not

concede, Horikiri fails to cure the deficiencies of Aaker discussed above. That is, Horikiri does not teach or suggest "[a] computer program product, tangibly embodied in a storage medium, comprising instructions operable on a client computer to ... pre-process one or more of the possible user interaction events to generate one or more possible user interface states," as recited in claim 1, and required by claim 5.

Accordingly, Aaker and Horikiri fail to establish a *prima facie* case of obviousness with respect to claim 5, at least because the references fail to teach each and every element required by the claim.

V. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Applicant respectfully requests that the Examiner respond to every point raised herein in accordance with M.P.E.P. § 707.07(f). Should the Examiner continue to dispute the patentability of the claims after consideration of this response, Applicant encourages the Examiner to contact Applicant's undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.
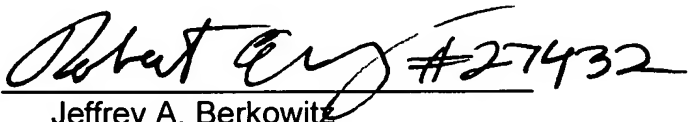
Please grant any extensions of time required to enter this response and charge

any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 26, 2007   By: _____

Jeffrey A. Berkowitz
Reg. No. 36,743